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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,369	11/14/2003	Peter M. Beasley	NETW:1000RCE	9152
34725 7590 02/03/2009 CHALKER FLORES, LLP 2711 LBJ FRWY Suite 1036 DALLAS, TX 75234				
EXAMINER				
LE, MICHAEL				
ART UNIT		PAPER NUMBER		
2163				
MAIL DATE		DELIVERY MODE		
02/03/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/713,369

**Applicant(s)**

BEASLEY, PETER M.

**Examiner**

MICHAEL LE

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 10, 12-15, 17-20 and 22-33 is/are pending in the application.
- 4a) Of the above claim(s) 23-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 10, 12-15, 17-20, 22, 32 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 15, 2008 has been entered.

### ***Summary and Status of Claims***

1. This Office Action is in response to Applicant's reply filed November 11, 2008.
2. Claims 1-5, 10, 12-15, 17-20, and 22-33 are pending.
3. Claims 23-31 are withdrawn from consideration for being directed to a non-elected invention.
4. Claims 3-5 and 10 are rejected under 35 U.S.C. 112, second paragraph.
5. Claims 3-5, 10, 12-15, 17-2, 22, 32, and 33 are rejected under 35 U.S.C. 101.
6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Drawings***

7. The drawings are objected to because figure 9 is a screenshot of insufficient quality as to allow repeated reproduction. A computer drawn screenshot with sufficient quality and clarity should be submitted as a replacement. Corrected drawing sheets in

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compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 3-5 and 10 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
9. Claims 3-5 and 10 recite a list of items included in a particular item. Each of the listings end with an "or." It is unclear whether all the items listed are to be included in

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the particular item or if only one of the list is required. For the prior art rejections below, it is interpreted that only one of the list is required.

10. The prior art rejections to claims 3-5 and 10 below are made as best understood in light of the rejection under 35 U.S.C. 112, second paragraph addressed above.

***Claim Rejections - 35 USC § 101***

11. **Claims 3-5, 10, 12-15, 17-20, 22, 32, and 33 are rejected under 35 U.S.C. 101**

because the claimed invention is directed to non-statutory subject matter.

12. The basis of this rejection is set forth in a test of whether the invention is categorized as a process, machine, manufacture or composition of matter. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) are found to be non-statutory subject matter. A method claim also must be either (1) tied to a particular machine or apparatus or (2) transform the underlying subject matter into a different state or thing.

13. In the present case, **claims 3-5 and 10** recite lists of items that are merely a complication or arrangement of data. Accordingly, the lists are considered nonfunctional descriptive material. *See* MPEP 2106.01. The limitations will not be given patentable weight. For the prior art rejections below, claims 3-5 and 10 will be treated as rejected due to their dependency on rejected independent claim 1.

14. **Claims 12-15, 17-19, and 22** recite a method that fails the aforementioned test. The method steps are not tied to a particular machine or apparatus either explicitly or implicitly. There is also no physical transformation of the underlying subject matter. Consequently, the method of claims 12-15, 17-19, and 22 are deemed nonstatutory.

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15. **Claim 20** is directed to a computer program embodied on a computer readable medium. The claim is directed toward the computer program and not the medium. The body of the claim further confirms this. A computer program can only be claimed in the form of a process and when doing so must be tied to a particular machine or apparatus or transform the underlying subject matter into a different state or thing. Here, the computer program is not claimed as a method and therefore cannot be properly categorized in a statutory category of invention. Therefore, claim 20 is deemed nonstatutory. The Examiner suggests claiming the computer readable medium storing the computer program to place the claim in a statutory category. Applicant is cautioned to ensure that the computer readable medium of the claim is directed only to physical media and not to transmission or carrier media. In addition, the Specification does not describe what is encompassed by computer readable medium. There is ambiguity in the limitation as it could potentially encompass nonstatutory subject matter, such as signals. Applicant is requested to make a positive statement that the medium of the claim does not encompass nonstatutory subject matter such as signals and other forms of transmission media.

16. **Claims 32 and 33** are deemed nonstatutory for the same reasons as claims 12-15, 17-19, and 22.

17. To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention

***Claim Rejections - 35 USC § 103***

18. **Claims 1-5, 10, 12-15, 17-20, 22, 32, and 33 are rejected under 35 U.S.C.**

**103(a) as being unpatentable over Wilkinson et al. (US Patent Pub 2002/0143775) (Wilkinson), in view of Bly et al. (US patent Pub 2002/0077944) (Bly).**

19. In regards to **claim 1**, Wilkinson discloses an apparatus for managing an infrastructure comprising:

- a. a computer (Wilkinson at para. 0020 “server”);
- b. a user interface communicably coupled to the computer (Wilkinson at para. 0020 “browser”);
- c. a database communicably coupled to the computer (Wilkinson at para. 0020), the database containing two or more records, each record having a unique identifier and one or more data fields representing attributes of an asset or asset related item within the infrastructure (Wilkinson at para. 0049, lines 1-4), and all the records are linked in a database structure to represent the assets and asset related items (1) in a hierarchical manner in accordance with one or more business rules of the infrastructure that define how the assets and asset related items are interconnected (Wilkinson at para. 0037-8<sup>1</sup>), and (3a) how one or more persons use the assets and asset related items (Wilkinson at Fig. 5; para 0034-5)<sup>2</sup>; and

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<sup>1</sup> Taxonomy is interpreted as “business rules.”

<sup>2</sup> The projects are created by a user and show how a user wishes to access the system (i.e., how the user uses the assets and related items).

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- d. a computer program embodied on a computer readable medium that is executed by the computer to manage the infrastructure using the database.

Wilkinson at para. 0021.

20. Wilkinson does not expressly disclose that the records in the database are linked to represent assets and asset related items (2) in a life cycle of the asset and asset related items.

21. Bly discloses an asset database containing records of assets with attributes such as operating life. Bly at fig. 14; para. 0146.

22. Wilkinson and Bly are analogous art because they are both directed toward the same endeavor of asset management.

23. At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the apparatus of Wilkinson by adding the feature of having the records in the database represent assets and asset related items (2) in a life cycle of the asset and asset related items, as taught by Bly.

24. The motivation for doing so would have been because the life cycle of an asset is important in determining characteristics of an asset, such as maintenance cost, sales value, etc. Bly at para. 0009.

25. In regards to **claim 2**, Wilkinson in view of Bly discloses the apparatus as recited in claim 1, wherein the one or more data fields further represent attributes of a sub-element for one or more assets. Wilkinson at para. 047.

26. **Claims 3-5 and 10** are rejected due to their dependency on claim 1. See the explanation in the 101 rejection above.



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27. In regards to **claim 12**, Wilkinson discloses a method for managing an infrastructure comprising the steps of:

- a. providing a database containing two or more records, each record having a unique identifier and one or more data fields representing attributes of an asset or asset related item within the infrastructure (Wilkinson at para. 0049, lines 1-4), and all the records are linked in a database structure to represent the assets and asset related items (1) in a hierarchical manner in accordance with one or more business rules of the infrastructure that define how the assets and asset related items are interconnected(Wilkinson at para. 0037-8<sup>3</sup>), and (3a) how one or more persons use the assets and asset related items (Wilkinson at Fig. 5; para 0034-5)<sup>4</sup>;
  - b. processing one or more user requests to display or report information stored in the database (Wilkinson at para. 0045); and
  - c. updating the database as asset or asset related items are procured, implemented, changed or disposed. Wilkinson at Fig. 11; para. 0081-4.
28. Wilkinson does not expressly disclose that the records in the database are linked to represent assets and asset related items (2) in a life cycle of the asset and asset related items.
29. Bly discloses an asset database containing records of assets with attributes such as operating life. Bly at fig. 14; para. 0146.
30. Wilkinson and Bly are analogous art because they are both directed toward the same endeavor of asset management.

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<sup>3</sup> Taxonomy is interpreted as "business rules."

<sup>4</sup> The projects are created by a user and show how a user wishes to access the system (i.e., how the user uses the assets and related items).

31. At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the apparatus of Wilkinson by adding the feature of having the records in the database represent assets and asset related items (2) in a life cycle of the asset and asset related items, as taught by Bly.

32. The motivation for doing so would have been because the life cycle of an asset is important in determining characteristics of an asset, such as maintenance cost, sales value, etc. Bly at para. 0009.

33. In regards to **claim 13**, Wilkinson in view of Bly discloses the method as recited in claim 12, further comprising the step of creating the database. Wilkinson at para. 0075.

34. In regards to **claim 14**, Wilkinson in view of Bly discloses the method as recited in claim 13, wherein the step of creating the database comprises the steps of:

- a. identifying one or more boundaries for the infrastructure (Wilkinson at para. 0018<sup>5</sup>);
- b. identifying the assets within the boundaries (Wilkinson at para. 0036);
- c. identifying the items related to the assets (Wilkinson at para. 0060);
- d. identifying one or more persons that use the assets and asset related items (Wilkinson at para. 0051; para. 0087);
- e. determining the attributes associated with each asset and asset related item (Wilkinson at para. 0035; para. 0041; para. 0045);

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<sup>5</sup> The number of ingest stations is interpreted as one or more boundaries because the ingest stations make up the infrastructure.

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- f. determining the business rules of the infrastructure that define how the assets and related items are interconnected (Wilkinson at para. 0051; para. 0058; para. 0060); and
  - g. creating each record and storing the record in the database. Wilkinson at para. 0075.
- 35. In regards to **claim 15**, Wilkinson in view of Bly discloses the method as recited in claim 14, further comprising the steps of:
  - a. determining one or more sub-elements for the assets and one or more attributes associated with the sub-elements (Wilkinson at para. 0047); and
  - b. determining one or more business rules for how the sub-elements and assets are linked. Wilkinson at para. 0047.
- 36. In regards to **claim 17**, Wilkinson in view of Bly discloses the method as recited in claim 14, further comprising the step of identifying one or more people who use information about the asset. Wilkinson at para. 0087<sup>6</sup>.
- 37. In regards to **claim 18**, Wilkinson in view of Bly discloses the method as recited in claim 14, further comprising the step of designing data display and report formats. Bly at para. 0128; para. 0146.
- 38. In regards to **claim 19**, Wilkinson in view of Bly discloses the method as recited in claim 14, further comprising the steps of:
  - a. identifying a managing agency (Wilkinson at para. 0007; para. 0087); and
  - b. determining one or more goals for the managing agency. Wilkinson at para. 0087<sup>7</sup>.

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<sup>6</sup> Travel agents are one or more people who use information about the assets.

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39. **Claim 20** is essentially the same as claim 12 in the form of a computer program on a computer readable medium and is therefore rejected for the same reasons.

Wilkinson at para. 0021.

40. In regards to **claim 22**, Wilkinson in view of Bly discloses the method as recited in claim 12, further comprising the step of determining who or what is affected by a change in one or more of the assets or asset related items using the one or more business rules and the hierarchy. Wilkinson at para. 0035<sup>8</sup>.

41. In regards to **claim 32**, Wilkinson discloses a method of using an asset management system comprising the steps of:

- a. providing a database containing two or more records, each record having a unique identifier and one or more data fields representing attributes of an asset or asset related item within the infrastructure (Wilkinson at para. 0049, lines 1-4), and all the records are linked in a database structure to represent the assets and asset related items (1) in a hierarchical manner in accordance with one or more business rules of the infrastructure that define how the assets and asset related items are interconnected(Wilkinson at para. 0037-8<sup>9</sup>), and (3a) how one or more persons use the assets and asset related items (Wilkinson at Fig. 5; para 0034-5)<sup>10</sup>; and

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<sup>7</sup> The managing agency is interpreted as a traveling agency because they manage and use the assets. Their customizations and preferences is interpreted as "determining one or more goals for the managing agency."

<sup>8</sup> Projects are created by users. Changes to the assets would affect the projects and in turn the users. These affects are determined through the hierarchy shown in Fig. 5.

<sup>9</sup> Taxonomy is interpreted as "business rules."

<sup>10</sup> The projects are created by a user and show how a user wishes to access the system (i.e., how the user uses the assets and related items).

- b. determining who or what is affected by a change in one or more of the assets or asset related items using the one or more business rules and the hierarchy. Wilkinson at para. 0035<sup>11</sup>.
42. Wilkinson does not expressly disclose that the records in the database are linked to represent assets and asset related items (2) in a life cycle of the asset and asset related items.
43. Bly discloses an asset database containing records of assets with attributes such as operating life. Bly at fig. 14; para. 0146.
44. Wilkinson and Bly are analogous art because they are both directed toward the same endeavor of asset management.
45. At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the apparatus of Wilkinson by adding the feature of having the records in the database represent assets and asset related items (2) in a life cycle of the asset and asset related items, as taught by Bly.
46. The motivation for doing so would have been because the life cycle of an asset is important in determining characteristics of an asset, such as maintenance cost, sales value, etc. Bly at para. 0009.

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<sup>11</sup> Projects are created by users. Changes to the assets would affect the projects and in turn the users. These affects are determined through the hierarchy shown in Fig. 5.

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47. In regards to **claim 33**, Wilkinson in view of Bly discloses the method as recited in claim 32, further comprising the steps of:

- a. adding one or more records to the database for one or more new assets, new persons, new attributes, new business rules and new boundaries (Wilkinson at para. 0081-4);
- b. providing one or more data screens and reports to the users of the system (Wilkinson at para. 0045);
- c. receiving data from automated systems and storing the received information in the database (Bly at para. 0046); and
- d. customizing the system for one or more applications. Wilkinson at para. 0089.

***Response to Amendment***

**Rejection of Claims 1-5, 10, 12-15, 17-20, 22, 32, and 33 under 35 U.S.C 112,**

**First/Second Paragraph**

48. Applicant's amendment to claims 1, 12, 20, and 32 is acknowledged. Applicant's arguments have been fully considered and are persuasive. The rejections under 35 U.S.C. 112, first paragraph are withdrawn. The rejections for claims 1, 2, 12-15, 17-20, 22, 32, and 33 under 35 U.S.C. 112, second paragraph are withdrawn. Claims 3-5 and 10 remain rejected for the reasons set forth in the rejection above. The rejection to claims 3-5 and 10 under 35 U.S.C. 112, second paragraph is maintained.

**Rejection of Claims 1-5, 10, 12-15, 17-20, 22, 32, and 33 under 35 U.S.C 101**

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49. Applicant's arguments have been fully considered but are moot in view of the new grounds of rejection set forth above. Consequently, the rejection to claims 1-5, 10, 12-15, 17-20, 22, 32, and 33 under 35 U.S.C. 101 is maintained.

***Conclusion***

50. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Le whose telephone number is 571-272-7970.

The examiner can normally be reached on Mon-Thurs : 9:30am-6pm, Fri: 8am-4:30pm.

51. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

52. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael Le/  
Examiner, Art Unit 2163  
2/2/2009

/Wilson Lee/  
Primary Examiner, Art Unit 2163